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| <b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>  |  | <b>Docket Number (Optional)</b><br>0026119.0136CUS1   |  |
|   | <b>Application Number</b><br>09/696,754-Conf.<br>#3113 | <b>Filed</b><br>October 25, 2000  |  |
|   | <b>First Named Inventor</b><br>Bob LAMOUREUX et al.    |   |  |
|   | <b>Art Unit</b><br>3627                                | <b>Examiner</b><br>J. A. Fischetti  |  |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).<br/>Note: No more than five (5) pages may be provided.</p>  |  |   |  |
| <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest.<br/>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record.<br/>Registration number 35,120</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.<br/>Registration number if acting under 37 CFR 1.34. _____</p> |  | <p><br/>Signature</p> <p>Ira H. Donner<br/>Typed or printed name</p> <p>(212) 230-8800<br/>Telephone number</p> <p>November 21, 2006<br/>Date</p> |  |
| <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>   |  |   |  |
| <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>   |  |   |  |

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and Trademark Office, facsimile no. (571) 273-8300, on the date shown below.

Dated: November 21, 2006

Signature:  (Ira H. Donner)

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Attorney Docket No. 26119-136C US1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE PATENT APPLICATION

Applicants : Bob Lamoureux et al. Confirmation No.: 3113  
Application No. : 09/696,754 Group Art Unit: 3627  
Filed : October 25, 2000 Examiner: J. A. Fischetti  
For : METHODS AND APPARATUS FOR MANAGING INFORMATION  
RELATED TO SUBJECT MATTER OF COMMERCIAL TRANSACTIONS

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**PRE-APPEAL BRIEF**

Dear Sir:

In response to the Office Action mailed August 24, 2006 ("the Current Action"), Applicants submit a Notice of Appeal, and the following Pre-Appeal Brief Request for Review.

**Restriction History**

The present application is related to U.S. Application number 09/697,024 ("the '024 application") and U.S. Application number 09/696,765 ("the '765 application").

The '024 Application was filed with 43 claims and the Examiner required restriction and listed nine groups of inventions. The '765 application was filed with 32 claims and has been restricted into 5 inventions with one of the inventions having seven distinct species.

The present application was filed with 58 claims. In the Restriction Requirement mailed August 27, 2003, the Examiner required restriction and listed seven groups of inventions. After 16 new claims were added in the Amendment filed May 11, 2004, further restriction was required, in the Interview of June 24, 2004, among 3 groups of inventions. In addition, the Examiner indicated that the selected group had three species and accordingly required selection of a species in the selected group.

Thus, between the three related applications, it appears that the Examiner has found 30 groups of patentably distinct subject matter. Claims 1-10, 12, 59-67, and 88 of the present application are at least twice rejected. Applicants respond to the rejections below.

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**I. Rejection of Claim 88 Under 35 U.S.C. § 112**

The Examiner stated on page 2 of the Office Action issued January 26, 2006 ("Final Action") that claim 88 is indefinite because "there is recited only one first and one second networked user." In the Amendment filed March 25, 2006 ("Final Response"), Applicants amended claim 8 to recite, "with at least one of first networked users and one of second networked users"

The Examiner also stated that "[i]f both users are recited ... the users could be sending information to themselves" (Final Action, page 2). Applicants noted that claim 88 states that the information bundles are "to be received from at least one of the first networked users and adapted to be sent to at least one of the second networked users" (Final Response, Page 9). Applicants respectfully submit that the claims are definite.

**II. Rejection of the Claims 1, 2, 3, 5-10, 12, 59-63, 65-67 and 88 Under 35 U.S.C. § 103****A. The Examiner Has Not Indicated What He Believes to Show or Suggest Each Limitation of Claim 1**

Claim 1 was amended in the response filed July 7, 2005 ("July Reply") to include that "each of the information bundles includes values for a plurality of information fields characterizing commercial interactions associated with at least one of the first and second plurality of different networked users." As noted on page 5 of the Final Response, the Examiner has given no indication of what he believes to show or suggest this limitation. Despite being informed of this, the Examiner did not provide any further rejection or response in the Office Action issued August 24, 2006 ("Current Action").

**B. Bowman does not Show or Suggest Deriving Traffic Statistics for the Step of Distributing Based on Values for the Content Attribute Descriptors**

The Examiner states that Bowman U.S. Patent No. 6,601,234 ("Bowman") "discloses deriving attribute values for the purpose of auditing" and that "[i]t is deemed an obvious variant of auditing to derive traffic statistics since that is what auditing is" (Final Action, page 3). As noted on page 10 of the Final Response and page 13 of the July Reply, **this reasoning is circular**, and therefore, the Examiner has **not provided a prima facie case of obviousness**.

Also, as noted on page 10 of the Final Response and page 13 of the July Reply, the Applicant disagrees that it is an obvious variant of auditing to derive traffic statistics with respect to the claimed combination. Applicant requested the Examiner to provide a prior art reference describing this allegedly well known feature in the context of the present invention or an affidavit under 37 C.F.R. § 1.104(d)(2) providing details of why it would have been obvious. The Examiner has provided neither.

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Additionally, the Examiner cites a portion of Bowman that merely states that "attribute values may be obtained for auditing or rollback purposes" (Bowman-'234, column 200, lines 43-44). However, the Examiner has not pointed out how the Bowman reference shows that traffic statistics are derived based on the values for the content attribute descriptors.

Accordingly, Bowman-'234 does not show or suggest, for example, "deriving traffic statistics for the step of distributing based on values for the content attribute descriptors," as required by claim 1.

**C. The Examiner Has Failed to Show Where Business Language Definition Descriptors that Specify the Descriptive Metadata of Each of the Information Bundles are Shown in the Bowman Reference**

As noted on page 10 of the Final Response, in rejecting independent claim 1, the Examiner cites portions of Bowman-'234 that merely disclose data of messages sent from a sending system to a receiving system, where the data are translated based on metadata. In particular, the Bowman reference describes creating a stream that contains message data and metadata, and using a message language to read the formatting information and metadata off of the stream. The Examiner has failed to show where business language definition descriptors that specify the descriptive metadata of each of the information bundles are shown in the Bowman reference.

**D. The Proposed Combination of Milsted and Bowman Does Not Result in the Claimed Invention and Even if it Did, the Combination is Improper**

As noted on pages 11-12 of the Final Response, the Examiner also states that Milsted et al. U.S. Patent No. 6,345,256 ("Milsted") "derives by billing statistics based on the Product ID data in the metadata" and that Milsted uses "metadata to package content 113 for electronic distribution and then uses store 1-3 which uses the metadata for billing because it cannot access the content. (Final Action, pages 3-4). The Examiner further states that it would have been obvious to combine Milsted and Bowman. The Applicants respectfully disagree both because the proposed combination does not result in the claimed invention, and because even if it did, the proposed combination is improper.

Also as noted on pages 11-12 of the Final Response, Milsted is not related to the present invention, but relates to a method of automatically retrieving data associated with content. An identifier is read that is stored on electronic readable medium storing content.

In Milsted, Clearinghouse 105 keeps a record of all transactions and can report them to responsible parties, such as Electronic Digital Content Store 103 and Content Provider 101, on an immediate, periodic, or restricted basis. This reporting can obtain an audit trail of electronic delivery to their customers. Clearinghouse 105 can also notify Content Provider 101 and/or Electronic Digital Content Store 103 if it detects that information has been compromised or does not comply with the Content's Usage Conditions.

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Accordingly, Applicant disagrees with the Examiner that combining Bowman '234 and Milsted results in the presently claimed invention. Withdrawal of this rejection is respectfully requested.

Furthermore, the combination proposed by the Examiner is not suggested in either Milsted or Bowman and is therefore the result of impermissible hindsight reconstruction.

**E. Bowman and Lipkin do not Show or Suggest  
Managing Commercial Interactions Between Users Using Information Bundles**

The Examiner admits that Bowman-'234 does not disclose managing interactions between networked users using the information bundles. However, the Examiner states that "Lipkin discloses matching between metadata-based profiles and users (see cols. 113, 114, 115) to manage interactions e.g. matches between users." However, these columns of Lipkin U.S. Patent No. 6,721,747 ("Lipkin"), as the Examiner notes, refer to using profiles to "match information with users" (col. 113, lines 55-56). In contrast to the "managing commercial interactions ... using the information bundles," as required by claim 1, Lipkin is instead concerned with "employ[ing] meta-data based profiles to mach information with users" (col. 113, lines 55-56) and "matching of web resources" to "deliver a wide variety of resources, from webpages to Business Objects" (column 114, lines 34-36).

As asserted on page 12 of the Final Response, even if the combination suggested by the Examiner did show or suggest limitations of the claimed invention, which it does not, the proposed combination is not suggested in either Bowman or Lipkin and is therefore the result of impermissible hindsight reconstruction.

**F. The Applicant's Requests to the Examiner to Provide an  
Affidavit or Prior Art Reference Has Not Been Answered**

The Examiner states in connection with claim 65 that Official Notice is taken regarding the standard format of bundles. On page 13 of the July Reply and on page 13 the Final Response, the Applicant requested the Examiner to provide an affidavit or prior art reference, since Applicant does not believe that the present invention utilizes a standard format of bundles. This request has not been answered.

**G. The Claimed Statistics Limitation are Not an Intended Use**

The Examiner states in connection with Claims 66 and 67, that what the statistics are used for is an intended use. Applicants respectfully disagreed and asserted related arguments on pages 13-14 of the Final Response and on pages 15-17 of the July Reply and in support of Applicant's argument, cited the Manual of Patent Examining Procedure (MPEP) § 2173.05(g) and noted and discussed that the Federal Circuit has confirmed that data is to be provided patentable weight over the prior art<sup>1</sup>.

Accordingly, withdrawal of the rejections is respectfully requested.

<sup>1</sup> In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed Cir. 1994)

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**III. Rejection of the Claims 1, 4 and 64 Under 35 U.S.C. § 103**

As discussed on pages 14-15 of the Final Response and pages 17-18 of the July Reply, the Examiner has not provided clear guidance why one would have combined the Bowman, Milsted et al. and U.S. Patent 6,625,643 to Colby et al ("Colby") references, and even if combined, how the proposed combination results in the claimed invention. Colby et al. appears wholly irrelevant to the present invention.

The Examiner admits that "Bowman fails to disclose an event table to manage data based on user definable properties, e.g. events" but that "Colby et al. do disclose such a table" (Office Action, page 6). The Examiner, however, gives no indication of what in Colby he believes to be "such a table." Furthermore, the Examiner gives no indication of how the unidentified table in Colby, for example, "provides a sequence of activities with priorities, dependencies, execution methods, and requirements" as recited in claim 64.

The Examiner also states that "the event table in Colby et al. is read as the processing logic which is obviously capable of prioritizing billing" (Office Action, page 6). However, the Examiner gives no indication of why the event table could be "processing logic" or, again, how Colby relates in any way to "convert[ing] traffic to billing amounts" as recited, for example, in claim 4. Accordingly, withdrawal of the rejections is respectfully requested.

**IV. Rejection of Claims 1-10, 12, 59-67, and 88 Under 35 U.S.C. § 101**

Despite making no such rejection in the previous Office Actions, claims 1-10, 12, 59-67, and 88 have been rejected, in the Current Action, under 35 U.S.C. § 101 because there is allegedly "no recitation of a tangible and concrete result deriving from the solution activity process steps" (Current Action, page 2). It is unclear what in the claims the Examiner is referring with the phrase "solution activity process steps."

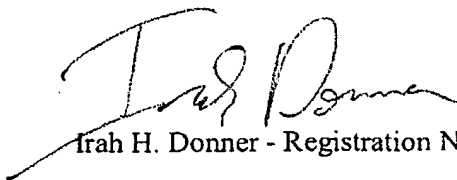
However, Applicants assert that, for example, claims 1 and 88 meet the requirements of 35 U.S.C. § 101 because, for example, they recite "network commercial interaction method[s]" that include, for example, "distributing information bundles," "managing commercial interactions," "deriving traffic statistics for the step of distributing the information bundles," each of which achieve a concrete and tangible result. Additionally, both claims include, for example, specify "descriptive metatdata" which is accordingly limited to a digital data processing device. Accordingly, withdrawal of the rejections is respectfully requested.

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11/21/06

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